

**REMARKS**

The issues outstanding in the instant application are the following:

- The disclosure is objected to.
- The claims are objected to.
- Claims are rejected under 35 U.S.C. § 102.
- Claims are rejected under 35 U.S.C. § 103.

Applicant traverses the outstanding rejections and respectfully request reconsideration based on the amendments and remarks presented herein. Claims 2-16 are original, claim 1 is currently amended, and claims 17-21 are canceled without prejudice. Claims 1-16 are pending in this application. In view of the cancellation of claims 17-21, rejections of claims 17-21 in the Office Action are not responded to herein.

**Objection to the Disclosure:**

Applicant has corrected the disclosure as required in section 1 of the Office Action. Applicant has corrected one minor error in addition to those required by the Office Action (changing “foams” to “foam”). No new matter has been entered.

**Objections to the Claims:**

Claims 17-21 have been canceled without prejudice. Accordingly, the objections to claims 17-21 are now considered moot.

**Changes to the Claims:**

Claim 1 has been amended to correct a minor error. Claims 17-21 have been canceled without prejudice. No new matter has been added.

**Rejection under 35 U.S.C. §102:**

Claims 1, 2, 5-9, 11, and 14-19 are rejected under 35 U.S.C. § 102(b) as being anticipated by Sugiyama et al. (Japanese Patent Publication No. 08-179613, hereafter Sugiyama). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil*

*Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicant respectfully traverses the outstanding rejection.

Claims 8 and 11 recite the limitations “a toner hopper having a flat surface” and “a feed roller compartment having a flat surface.” Claim 11 further recites “when said sealing member is sandwiched between said two flat surfaces around said openings.” Claim 1 recites the related limitation “when said two flat surfaces engage each other” referring to the engagement of the surfaces of the toner hopper and the feed roller compartment. Sugiyama does not describe these limitations.

The Office Action presents the embodiments in FIGS. 10 and 12 and in the Abstract of Sugiyama as anticipating the limitations of Applicant’s claims. In the embodiment shown in the Abstract, the surface of toner container 12 which will engage development unit 10 includes a groove 16 for receiving sealing member 17. Thus, the surface of toner container 12 which will engage the development unit 10 of Sugiyama is clearly not flat, having as it does, a square-edged groove cut therein. Please see the uppermost two figures on page 1 of the translated patent Abstract.

In the embodiment of FIG. 10 of Sugiyama, the surface of toner container 12 which will engage the development unit 10 includes projections 24 to which sealing member 17 is affixed. The engaging surface of toner container 12 is therefore clearly not flat or generally flat. Similarly, in FIG. 12, the surface, indicated as surface 11a, of the development unit 10 which will engage toner container 12 includes projections 24 to which sealing member 17 is affixed. Thus, this surface is also neither flat nor generally flat.

Thus, claims 1, 8, and 11 are not anticipated by Sugiyama. Claims 2 and 5-7 depend from claim 1, claim 9 depends from claim 8, and claims 14-16 depend from claim 11, and the dependent claims inherit all the limitations of their respective independent claims. Moreover, the dependent claims define further novel, nonobvious limitations not described in the prior art. Thus, the dependent claims are patentable over Sugiyama for the same reasons as their respective independent claims. Limitations of a selection of the dependent claims are discussed below.

Claims 6 and 15 recite the limitation “wherein said mechanical fixture comprises a plurality of screws. Sugiyama recites “[d]rawing 16 shows the example which prepared two or more protruding line [sic] 24b in the side face of projection 24.” See Sugiyama patent translation, paragraph [0025]. The foregoing quotation and FIG. 16 indicate that the protruding lines of the modified projection (24) of the embodiment of FIG. 16 do not describe a “screw” as there is no description or illustration of the lines being threaded. Thus, claim 6 and 15 define patentable limitations in addition to those they inherit from their respective independent claims. For the foregoing reasons, claims 1, 2, 5-9, 11, and 14-16 are patentable over Sugiyama under 35 U.S.C. § 102(b).

**Rejection under 35 U.S.C. § 102(b):**

Claims 1, 2, 8, 9, 11, and 17-21 are rejected under 35 U.S.C. § 102(e) as being anticipated by Wang et al. (U.S. Patent No. 6,721, 525, hereafter Wang). Applicant respectfully traverses the outstanding rejection.

Claims 8 and 11 recite the limitations “a toner hopper having a flat surface” and “a feed roller compartment having a flat surface.” Claim 11 further recites “when said sealing member is sandwiched between said two flat surfaces around said openings.” Claim 1 recites the related limitation “when said two flat surfaces engage each other” referring to the engagement of the surfaces of the toner hopper and the feed roller compartment. Wang does not describe these limitations.

The first container 1 of Wang, equated to Applicant’s feed roller compartment by the Office Action, includes at least one guiding member 31 (see FIG. 8 and col. 9, lines 10-11) on the very surface (109) which engages the second container 2. Surface 109 is therefore demonstrably not “flat.” Moreover, since there is a consistent pattern of placement of guiding members 31 on surface 109, as illustrated in FIG. 8, Applicant contends that surface 109 of the first container 1 of Wang is also not generally flat. Accordingly, Wang does not describe all the limitations of Applicant’s independent claims 1, 8, and 11.

Claim 2 depends from claim 1, and claim 9 depends from claim 8, and the dependent claims both inherit the limitations of their respective independent claims. Accordingly, claims 2

and 9 are patentable over Wang for the same reasons as claims 1 and 8, respectively. Accordingly, claims 1, 2, 8, 9, and 11 are patentable over Wang under 35 U.S.C. § 102(b).

**Rejection under 35 U.S.C. § 103(a):**

Claims 3, 4, 10, 12, and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wang in view of De Kesel et al. (U.S. Patent No. 6,760,556, hereafter De Kesel). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criterion, Applicant contends that the references provided do not teach or suggest all the limitations of the rejected claims and that there is no motivation to combine the references.

Applicant notes that the dependent claims rejected in this section depend from independent claims which Applicant has already shown to define limitations not taught or suggested by Wang. Moreover, the Office Action section rejecting these dependent claims under 35 U.S.C. § 103(a) does not cure these deficiencies. Accordingly, rejected dependent claims 3, 4, 10, 12, and 13 are patentable over Wang in view of De Kesel by virtue of the limitations recited in their respective independent claims, aside from the arguments presented below.

Claim 3 recites the limitation “wherein said sealing foam has an upper surface adapted to be fixed to said bottom surface of said feed roller compartment by an adhesive.” The other rejected dependent claims recite similar limitations. The Office Action admits, on page 6, that Wang does not disclose this limitation. Moreover, De Kesel also does not teach or suggest this limitation.

The Office Action asserts that, in De Kesel, an adhesive 4 is used for fixing sealing foam 10 to the toner hopper of De Kesel. However, the sealing foam of De Kesel is not affixed to the toner container at all. In De Kesel, face 1A of sealing film 1 is provided with an adhesive for connection to the toner cartridge. Foam layer 10 is attached to the other face of sealing film 1,

face 1B. Thus, the foam layer of De Kesel does not contact the toner cartridge, with or without adhesive. See FIG. 8, col. 11, lines 22-24, col. 12, lines 56-61, and col. 13, lines 18-20. Thus, disclosure of De Kesel does not teach or suggest the limitation of claim 3. Therefore, the combination of Wang and De Kesel does not teach or suggest all the limitations of Applicant's claims and thus does not satisfy the third criterion of the *prima facie* case of obviousness under M.P.E.P. § 2143.

Applicant further contends that there is no motivation to combine De Kesel with Wang. The foam members 112 and 212 of Wang are disclosed as being present to address the problem of toner spilling in between the openings between two attached toner containers which together form toner supplying container 200. See Wang, col. 13, lines 13-46. A first of these containers is for receiving toner, and the second container is for accommodating toner and providing toner to the first container. See col. 1, lines 48-52. In contrast, the disclosure of De Kesel is directed to the problems arising when tearing a strip covering an opening of a toner container by an operator, which is implicitly a human operator. At the stage at which the strip is removed by the operator, the container of De Kesel could not yet be in operation within a printer or other machine. Accordingly, Applicant contends that one of skill in the art, seeking to modify a mechanism associated with the transfer of toner between two constituent parts of a toner container as part of the operation of a machine including this container (as in Wang), would not look to a disclosure directed to preventing the soiling of the hands or clothing of a human operator upon the operator's removal of a sealing strip from a toner container, prior to the toner container's installation as part of a printer or other machine.

Based on the foregoing, Applicant contends that the first criterion of the *prima facie* case of obviousness under M.P.E.P. § 2143 has not been met. Because there is no motivation to combine the references and because the proffered combination of prior art does not teach or suggest all the limitations of the rejected claims, claims 3, 4, 12, and 13 are patentable over Wang in view of De Kesel under 35 U.S.C. § 103(a).

**Conclusion:**

Based on the foregoing, Applicant contends that all pending claims are allowable and respectfully requests that the instant case be passed to issue. The Examiner is invited to call the below-listed attorney to resolve any outstanding matters. The Commissioner is hereby authorized to deduct any fees believed due from, or credit any overpayment to, our Deposit Account No. 11-0223.

Dated: January 19, 2005

Respectfully submitted,

By \_\_\_\_\_

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I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to the MS: Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: January 19, 2005 Signature:

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